

REMARKS

Upon entry of this amendment, claims 24, 25, 27, 28, 34-36, 38, and 40-54 will be pending in the application. Claims 24, 25, 27, 28, 38, and 40 are amended to recite nucleic acid molecules, as supported throughout the specification, for example, at page 4. Claims 24 and 27 are amended to recite nucleic acid molecules encoding human histamine H3 receptor comprising an amino acid sequence of SEQ ID NO:7, as supported by Figure 3 of the specification. Claims 24, 27, 38, and 40 are amended to recite histamine H3 receptor homologues comprising biological activity of a human histamine H3 receptor comprising an amino acid sequence of SEQ ID NO:7, as supported at pages 5-6 of the specification. Claims 38 and 40 are amended to omit recitation of the term “fragment.” Claims 26, 29-33, 37, and 39 are canceled. Claims 41-54 are added as supported in the specification at pages 3-4. The title has been amended. No new matter is introduced by this amendment.

The withdrawn claims are canceled.

Withdrawn claims 37 and 39 are canceled in view of the finality of the restriction requirement. Applicants reserve the right to pursue the nonelected subject matter at a later date.

The objection to the specification should be withdrawn.

The title of the specification has been amended to “Methods of Use of DNA Encoding a Human Histamine Receptor of the H3 Subtype.” Withdrawal of the objection to the specification is respectfully requested.

Claims 24, 27, 34-36, 38, and 40 satisfy the written description requirement.

Claims 24, 26, 27, 29-36, 38, and 40 are rejected under the first paragraph of 35 U.S.C. § 112 for alleged lack of written description. Claims 26 and 29-33 have been canceled. Applicants respectfully note that canceled claim 26 did not recite a fragment. Although Applicants disagree with the rejection, in an effort to advance prosecution of the application, claims 24 and 27 have been amended to recite human histamine H3 receptor of

SEQ ID NO:7, and claims 38 and 40 have been amended to omit reference to a fragment. Withdrawal of the rejection is thus respectfully requested.

Claims 24, 27, 34-36, 38, and 40 are enabled.

Claims 24, 26, 27, 29-36, 38, and 40 are rejected under the first paragraph of 35 U.S.C. § 112 for alleged lack of enablement. Although Applicants disagree with the rejection, claims 24, 27, 38, and 40 have been amended to overcome the rejection.

To the extent the rejection is applied to the amended claims, Applicants traverse. One of ordinary skill in the art at the time of the invention would have been able to make and use all nucleic acid molecules encoding a human histamine H3 receptor having an amino acid sequence of SEQ ID NO:7 in the presently claimed methods without undue experimentation. The genetic code is based on correlation between amino acids and encoding codons such that identification of the amino acid sequence of a protein automatically puts one in possession of all nucleic acid sequences encoding that protein. As acknowledged by the Federal Circuit, “the complete amino acid sequence of a protein may put one in possession of the genus of DNA sequences encoding it.” *In re Wallach*, 378 F.3d 1330, 1333, 71 U.S.P.Q.2d 1939 (Fed. Cir. 2004).

Additionally, one of ordinary skill in the art would have been able to identify homologues having the recited function of human histamine H3 receptor activity without undue experimentation in view of the teachings of the present specification and the knowledge in the art. For example, the specification teaches that human histamine H3 receptor activity can be monitored by performing a ³H-alphamethylhistamine binding assay known in the art. (Specification, page 4.) The specification also teaches that thioperamide and alpha-methylhistamine are human histamine H3 receptor ligands. (Specification, page 3.) Additionally, it is taught in the specification that H3 histamine receptor activity can be measured by inhibition of adenylate cyclase in response to histamine or incorporation of GTP-gamma-S. (Specification, page 4.) One of ordinary skill in the art would have been able to use the methods of the invention to arrive at human histamine H3 receptor homologues with nothing more than routine experimentation.

Withdrawal of the rejection is thus respectfully requested.

Claims 24, 27, 38, and 40 comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph.

Claims 24, 27, 30, 38, and 40 are rejected for alleged failure to comply with the definiteness requirement of 35 U.S.C. § 112, second paragraph. Claim 30 has been canceled.

Claim 24, 27, 38, and 40 are rejected for alleged failure to recite specific hybridization conditions. Applicants respectfully assert that one skilled in the art would understand the hybridization conditions under which homologues of human histamine H3 receptor, including species homologues, could be identified in view of the knowledge in the art. Nonetheless, in an effort to advance prosecution of the application, Applicants have amended the claims to recite a histamine H3 receptor homologue having a biological activity of a human histamine H3 receptor having an amino acid sequence of SEQ ID NO:7. Withdrawal of the rejection is thus respectfully requested.

Claims 24 and 27 are patentable over U.S. Patent No. 5,882,893.

Claims 24 and 27 are rejected under 35 U.S.C. § 102(e) for alleged anticipation by U.S. Patent No. 5,882,983 to Goodearl *et al.* Although Applicants disagree with the rejection, in an effort to advance prosecution of the application, Applicants have amended the claims to recite histamine H3 receptor homologues comprising biological activity of a human histamine H3 receptor comprising an amino acid sequence of SEQ ID NO:7, as supported at pages 5-6 of the specification. As the record fails to establish that the cited reference teaches each limitation of the presently claimed invention, withdrawal of the rejection is respectfully requested.

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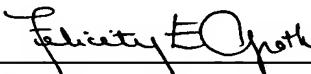
CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this application are in condition for allowance. The issuance of a Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, the undersigned may be contacted at 215-557-5908.

Respectfully submitted,

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